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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,691	10/28/2003	Tsutomu Noguchi	FUJZ 20.700	3923
26304 7590 01/02/2008 KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585			EXAMINER ALIA, CURTIS A	
			ART UNIT 2616	PAPER NUMBER
			MAIL DATE 01/02/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/694,691	<b>Applicant(s)</b> NOGUCHI, TSUTOMU	
	<b>Examiner</b> Curtis Alia	<b>Art Unit</b> 2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>22 August 2007</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. Claims 1, 2, 6, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable by Kung et al. (US 6,563,797).

For claim 1, Kung discloses a frame transfer method comprising a first step of generating, from a received frame, a monitored frame having a unique in-device information (see column 2, lines 31-40, the device is capable of replicating/duplicating packets to be monitored), and a second step of establishing a path corresponding to each of the generated frames (see figure 2, step 211, the IP-AMCP establishes the destination IP addresses of the monitoring stations, which establishes the path of the packet, as well as the destination IP address in the header of the original packet).

For claim 1, Kung does not teach that the first step generates a normally-transferred frame from the received frame. However, it is inherent that the received frame can be forwarded to the destination phone (rather than be duplicated and discarded). The end result of the method as taught by Kung results in a monitored frame and a normally transferred frame. Thus, it would have been obvious to a person having ordinary skill in the art at the time of the invention that a normally transferred frame would be the same as the received frame to be later forwarded to the destination address. The motivation to combine these teachings is that it would be more efficient to forward the already present packet than to generate an extra packet which is essentially the same as the original packet, and discard that original packet.

For claim 2, Kung discloses a step of determining whether the received frame is to be monitored (see figure 2, step 207, the device checks if the destination IP address is on the list of those to be monitored, the device proceeds to step 211 if the destination IP address is on the list).

For claim 2, Kung does not explicitly teach the step of generating a dual purpose frame from the received frame. However, this dual-purpose frame is a copy of the received frame, and can thus be explained as done in the rejection of claim 1 above. It is common sense to use the received packet rather than generating a copy and discarding the received packet.

Claims 6 and 7 are rejected under the same grounds as that of the method of claims 1 and 2.

2. Claims 3, 5, 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable by Kung in view of Kung et al. (US 6,496,483, hereinafter referred to as Kung 2).

For claim 3, Kung does not explicitly teach the step of multicasting the dual-purpose frame by editing header information of one of the multicasted frames for normal transferring and header information of the other frame for monitoring, and further editing both of the multicasted frames with header information corresponding thereto for the second step. Kung 2 teaches that the monitoring system is capable of sending the duplicated packets to multiple monitoring stations, whereby each monitoring station receives a packet (or other form of data such as PSTN analog signal) destined for itself, by receiving the packet) as shown in figure 2, steps 211-217). Thus, it would have been obvious to a person having ordinary skill in the art at the time of the invention that each monitoring station would be a separate destination for each copy of the packet data to be monitored. The motivation to combine these teachings is that the monitoring station need not be an IP monitoring station, but can reside on a different type of network.

For claim 5, Kung discloses that the step of determining whether the received frame is to be monitored is based on the destination address in the header information (see column 2, lines 31-39, the watchdog software determines that a designated telephone from a specific directory number DN or IP address for monitoring).

Claim 7 and 9 are rejected under the same grounds as those of the method of claims 3 and 5.

3. Claims 4 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kung in view of Kung 2 as applied to claim 1-2 and 6-7 above, and further in view of Foti (US 6,839,323).

For claim 4, Kung and Kung 2 do not explicitly teach that the predetermined header information includes a monitored ID as well as information necessary for restoring a normally-transferred ID and information used for monitoring, and generating two frames in which the monitored id of the dual-purpose frame is rewritten into an original flag and a monitored flag upon the multicasting, and further generating the normally-transferred frame and the monitored frame respectively by restoring a normally-transferred ID for header information of the frame having the original flag and rewriting header information of the frame having the monitored flag into a CPU-transferred ID. Foti, from the same field of endeavor, teaches that when sending packets to the monitoring station, the router encapsulates the packet with a new header identifying it as a monitored frame destined for the monitor ID and including the unique call ID. This enables the monitoring station to restore the original packet data when it is received. Thus, it would have been obvious to a person having ordinary skill in the art at the time of the invention to encapsulate the packet and introduce new header fields to indicate the type of packet

being sent/received and to be able to regenerate the original packet at the destination. The motivation to combine such teachings is that this will adapt the system to work on a wireless system.

Claim 9 is rejected under the same grounds as that of the method in claim 4.

***Response to Arguments***

4. Applicant's arguments with respect to claims 1 and 6 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Curtis Alia whose telephone number is (571) 270-3116. The examiner can normally be reached on Monday through Friday, 8am-5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doris To can be reached on (571) 272-7629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

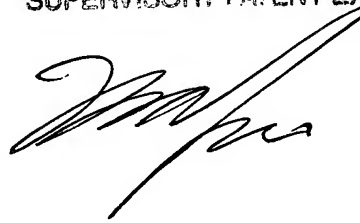
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CAA

KWANG BIN YAO  
SUPERVISORY PATENT EXAMINER

A handwritten signature in black ink, appearing to read 'Kwang Bin Yao', is written over the printed name and title.